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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/669,882	09/23/2003	Safaa H. Hashim	021756-060120US	5268
51206 7590 04/13/2010 TOWNSEND AND TOWNSEND AND CREW LLP/ORACLE TWO EMBARCADERO CENTER 8TH FLOOR SAN FRANCISCO, CA 94111-3834				
EXAMINER				
PASS, NATALIE				
ART UNIT		PAPER NUMBER		
3686				
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/669,882

**Applicant(s)**

HASHIM, SAFAA H.

**Examiner**

Natalie A. Pass

**Art Unit**

3686

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 19 February 2010 and 21 December 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 2-6, 8-12, 15-22, 24-28 and 31-39 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 2-6, 8-12, 15-22, 24-28, 31-39 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsman's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Notice to Applicant***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submissions filed on 19 February 2010 and 21 December 2009 have been entered.

2. This communication is in response to the Request for Continued Examination filed 19 February 2010 and the amendment filed on 21 December 2009. Claims 1, 7, 13-14, 23, 29-30 have been cancelled. Claims 2, 18, 34 have been amended. Grounds of rejection for claims 2-6, 8-12, 15-22, 24-28, 31-39 are set forth in detail below.

### ***Claim Objections***

3. Applicant is advised that should claim 36 be found allowable, claim 39 will be objected to under 37 CFR 1.75 as being a substantial duplicate thereof, for substantially the same reasons given in the previous Office Action (paper number 20091016). When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

*Claim Rejections - 35 USC § 112*

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claims 2-6, 8-12, 15-17, 34-39 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention for substantially the same reasons given in the previous Office Action (paper number 20091016). Further reasons appear hereinbelow..

(A) Claims 2 and 34 continue to recite limitations that are new matter, and are therefore rejected. The added material which is not supported by the original disclosure is as follows:

- “another of said tools and a second set of said data,” as disclosed in claim 2 at lines 28-29;
- “[a] computer-readable storage medium having stored thereon instructions for causing at least one processor to perform a method ... [...] ..,” as disclosed in claim 34 at lines 1-4; and
- “a second set of said data,” as disclosed in claim 34 at line 21.

35 U.S.C. 132 states that no amendment shall introduce new matter into the disclosure of the invention. "New matter" constitutes any material which meets the following criteria:

a) It is added to the disclosure (either the specification, the claims, or the drawings) after the filing date of the application, and

b) It contains new information which is neither included nor implied in the original version of the disclosure. This includes the addition of physical properties, new uses, etc.

In particular, the Examiner was unable able to find any support for this language within the specification as originally filed on 23 September 2003. Applicant is respectfully requested to clarify the above issues and to specifically point out support for these limitations in the originally filed specification and claims.

(B) Claims 3-6, 8-12, 15-17, 35-39 incorporate the features of independent claims 2 and 34, through dependency, and are also rejected.

Applicant is required to cancel the new matter in the reply to this Office Action.

6. If Applicant continues to prosecute the application, revision of the specification and claims to present the application in proper form is required. While an application can, be amended to make it clearly understandable, no subject matter can be added that was not disclosed in the application as originally filed on 23 September 2003.

***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**NOTE:** The following rejections assume that the subject matter added in the 19 June 2009 amendment are NOT new matter, and are provided hereinbelow for Applicant's consideration, on the condition that Applicant properly traverses the new matter objections and rejections made in sections 4-6 above in the next communication sent in response to the present Office Action.

8. Claims 2-6, 8-12, 15-22, 24-28, 31-39 are rejected under 35 U.S.C. 103(a) as being unpatentable over Surbey et al. (WO 0225470 A1) for substantially the same reasons given in the previous Office Action (paper number 20091016) and further in view of Grover et al., U.S Patent Application Publication Number 2002/0188484. Further reasons appear hereinbelow.

(A) As per newly amended claim 2, Surbey teaches a method for facilitating communication in an insurance-underwriting process (Surbey; page 12, paragraphs 1-2), the method comprising:

providing a plurality of participants access to a web-based computer system for storing and organizing data related to the insurance-underwriting process (Surbey; page 8, paragraph 1 to page 9, paragraph 1, page 12, paragraphs 1-2);

storing and organizing data related to the insurance-underwriting process at the web-based system (Surbey; Figure 2, page 8, paragraph 1 to page 9, paragraph 1, page 12, paragraphs 1-2);

enabling, by the web-based computer system, collaboration among at least two participants of said participants from the plurality of participants via the Internet using the web-based system (Surbey; Figure 9, Item 9440, page 8, paragraph 1 to page 9, paragraph 1, page 12, paragraphs 1-2), the web-based system comprising a multi-level modular architecture, the multi-level modular architecture comprising a plurality of applications, each application of the plurality of applications comprising a plurality of modules, (Surbey; Figure 2, Figure 9, page 14, paragraph 3, page 15, paragraph 2, page 21, paragraph 1 to page 22, paragraph 3);

sharing, by the web-based computer system, the at least a portion of said data among the plurality of participants (Surbey; Figure 9, Item 9440, page 6, paragraphs 1-3, page 8, paragraph 2),

making a determination of, by the web-based computer system, based on a role associated with at least one said at least two participants a first set of said data available to said at least one of said at least two participants (Surbey; Figure 9, Item 9314, page 8, paragraph 1 to page 9, paragraph 1, paragraph bridging pages 21-22); Examiner interprets Surbey's teachings of a "role-based permissions component" (Surbey; Figure 9, Item 9314, paragraph bridging pages 21-22) together with "[t]he software can enable the user to set "access rights" with respect to each collaborator. Those access rights can identify, specify, and/or determine whether the collaborator can "read only", "edit", and/or "delete" documents" (Surbey; page 8, paragraph 4)

and Surbey's teachings of "the unique workspace that the software has rendered for each collaborator, the workspace containing only those folders to which that collaborator has been granted access" (Surbey; paragraph bridging pages 8-9) to teach a form of this limitation;

Although Surbey teaches access to sub-folders determined by the "user's role" (Surbey; paragraph bridging pages 7-8), and "automatically providing a web page customized to the user's role in the web-enabled collaborative insurance process" (Surbey; claims 27-30), Surbey fails to explicitly disclose

each module of the plurality of modules comprising a plurality of tools, each tool of the plurality of tools comprising a plurality of views and comprising logic for performing at least one corresponding insurance underwriting function;

making a determination of, by the web-based computer system, based on a role associated with at least one said at least two participants, at least one of said tools available to said at least one of said at least two participants; and

restricting, by the web-based computer system, based on said determination, at least another of said tools and a second set of said data to said at least one of said at least two participants.

However, the above features are well-known in the art, as evidenced by Grover.

In particular, Grover teaches

each module of the plurality of modules comprising a plurality of tools, each tool of the plurality of tools comprising a plurality of views (Grover; Figure 6, Figure 7, paragraphs [0011],



[0050]-[0051], [0059]) and comprising logic for performing at least one corresponding insurance underwriting function (Grover; paragraphs [0062], [0067]-[0068]);

making a determination of, by the web-based computer system, based on a role associated with at least one said at least two participants, at least one of said tools available to said at least one of said at least two participants (Grover; Figure 9, Item 540, paragraphs [0009]-[0011], [0043], [0046], [0056], [0071]); and

restricting, by the web-based computer system, based on said determination, at least another of said tools and a second set of said data to said at least one of said at least two participants (Grover; Figure 9, Item 540, paragraphs [0009]-[0011], [0043], [0046], [0056], [0071]).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the method of Surbey to include these limitations, as taught by Grover, with the motivations of providing “a method and system for furnishing a real-time, on-line quote to a user for an insurance product, such as auto insurance, which frees up CSR personnel resources to focus on the sale of policies and reduces costs ... [...] ...” (Grover; paragraph [0006]).

(B) As per claims 3-4, Surbey and Grover teach a method as analyzed and discussed in claim 2 above

wherein said at least one of said two participants is selected from the group consisting of: insurance carriers, insurance agencies, insurance agents, and service providers (Surbey; page 12, paragraph 1);

wherein said at least one of said two participants is selected from the group consisting of: agents and “client advisor[s]” (reads on “case managers” (Surbey; page 12, paragraph 1, page 13, paragraph 5)).

(C) As per claim 5, Surbey and Grover teach a method as analyzed and discussed in claim 2 above, wherein the plurality of applications are adapted to employ a desktop visual metaphor for accessing the plurality of modules, said desktop visual metaphor including at least one selectable icon operable to activate at least one corresponding module (Surbey; Figure 5, Figure 9, page 4, paragraph 1, page 7, paragraph 4 to page 8, paragraph 3, paragraph bridging pages 11-12, page 12, paragraph 1, page 21, paragraph 1 to page 22, paragraph 2); Examiner submits that the applied Surbey reference teaches “software that incorporates an electronic folder structure ... [...] ... One way of visualizing this [metaphor] is an electronic filing cabinet that can provide the user with instant access to any file they have created or are entitled to access. These files can be accessed anywhere/anytime through an Internet connection” (Surbey; page 7, paragraph 4) and Surbey teaches “[b]y clicking on the folder (“explorer”) bar [i.e. a “selectable icon”], the user can select the appropriate folder and folder level ... [...] ... to select collaborators” (Surbey; page 8, paragraph 3); Examiner interprets these teachings to demonstrate a form of employing a desktop visual metaphor for accessing the modules, said desktop visual metaphor including at least one selectable icon operable to activate at least one corresponding module.

(D) As per claim 6, Surbey and Grover teach a method as analyzed and discussed in claim 2 above

wherein the plurality of modules are adapted to allow the plurality of applications to be scalable (Surbey; Figure 9, page 3, paragraph 5, page 7, paragraph 1, page 21, paragraph 1 to page 22, paragraph 2).

(E) As per claims 8-10, Surbey and Grover teach a method as analyzed and discussed in claim 2 above,

wherein the plurality of modules comprises: a user profile module; a general administration module; and a business module (Surbey; Figure 9, page 21, paragraph 1 to page 22, paragraph 2);

wherein the plurality of tools comprises at least one generic tool and at least one entity-specific tool (Surbey; page 8, paragraph 3, page 16, paragraph 2); and

wherein the at least one generic tool is adapted to operate in more than one module with similar functionality (Surbey; page 8, paragraph 3, page 16, paragraph 2).

(F) As per claims 11-12, 15, Surbey and Grover teach a method as analyzed and discussed in claim 2 above

wherein the plurality of views comprises: a summary view; a list view; and a detail view (Surbey; Figure 5, page 7, paragraph 4 to page 8 paragraph 1);

wherein the multi-layer, modular architecture is adapted to allow development of new applications, modules, tools, or views (Surbey; page 6, paragraph 6); and

wherein the step of sharing the data further comprises encrypting the data using a secure encryption technology (Surbey; Figure 9, Item 9520, page 22, paragraph 3).

(G) As per claims 16-17, Surbey and Grover teach a method as analyzed and discussed in claim 2 above

wherein said providing includes deploying the web-based system on a portal hosted by a third party (Surbey; page 6, paragraph 6 to page 7, paragraph 3, paragraph bridging pages 9-10, page 15, paragraph 1, page 21, paragraph 4); and

wherein the web-based system is deployed on a framework for a plurality of applications (Surbey; Figure 8, Figure 9, page 21, paragraph 1 to page 22, paragraph 3).

(H) Claim 18 differs from method claim 2, in that it is a system rather than a method for facilitating communication among participants in an insurance-underwriting process.

System claims 18-22, 24-28, 31-33 repeats the subject matter of claims 2-6, 8-12, 15-17, respectively, as a set of elements rather than a series of steps. As the underlying processes of claims 2-6, 8-12, 15-17, have been shown to be fully disclosed by the combined teachings of Surbey and Grover in the above rejection of claims 2-6, 8-12, 15-17, it is readily apparent that the system disclosed by Surbey and Grover includes the apparatus to perform these functions. As such, these limitations are rejected for the same reasons given above for method claims 2-6, 8-12, 15-17, and incorporated herein.

(I) Claims 34-39 differ from method claims 2, 8, 9, 2, 5, 9, respectively by reciting a “computer readable storage medium having stored thereon instructions for ...” in the preamble. As per this limitation, Surbey clearly discloses his invention to be implemented on a “computer readable storage medium having stored thereon instructions for ...” (Surbey; page 7, paragraph 4, page 16, paragraph 1). The remainder of claims 34-39 repeat the limitations of claims 2, 8, 9, 2, 5, 9, and are therefore rejected for the same reasons given above for claims 2, 8, 9, 2, 5, 9.

***Response to Arguments***

9. Applicant’s arguments filed 21 December 2009 have been fully considered but they are not persuasive. Applicant’s arguments will be addressed hereinbelow in the order in which they appear in the response filed 21 December 2009.

(A) As per Applicant’s argument on pages 9-10 of the response filed 21 December 2009 with regard to the rejections under 35 U.S.C. § 112, these arguments addressed whether or not three recitations were supported by the original disclosure:

1. “two participants,” as disclosed in claim 2 at lines 13-14, 29, and in claim 34 at lines 9 and 18-19;
2. “another of said tools and a second set of said data,” as disclosed in claim 2 at lines 28-29;
3. “a second set of said data,” as disclosed in claim 34 at line 21.

As per the first recitation (i.e. “two participants”), Applicant’s arguments and amendments were persuasive. Accordingly, this rejection has been withdrawn. However, as per

the second and third recitations listed above (i.e. “another of said tools and a second set of said data” and “a second set of said data”), Examiner was unable able to find any support in the originally filed specification for this newly added language within the paragraphs that were cited by Applicant in the response filed 21 December 2009. Accordingly, the rejections of recitations 2 and 3 under 35 U.S.C. § 112 are proper and are thus maintained. Moreover, Examiner respectfully notes that a fourth “new matter” limitation, also introduced in a newly added claim, does not appear to be supported by the original disclosure, i.e. “[a] computer-readable storage medium having stored thereon instructions for causing at least one processor to perform a method ... [...] ..,” as disclosed in claim 34 at lines 1-4. Accordingly, this recitation has been rejected under 35 U.S.C. § 112 as well.

(B) The remainder of Applicant’s argument on pages 11-15 of the response filed 21 December 2009 have been fully considered but they are moot in view of the new ground(s) of rejection.

***Conclusion***

10. The prior art made of record and not relied upon is considered pertinent to Applicant's disclosure. The cited but not applied references, Freeman et al., U.S. Patent Application Publication No. 2002/0059137, Snell et al., U.S. Patent Application Publication No. 2003/0233260, Sweeney, U.S. Patent Application Publication No. 2003/0065614, Kopold et al., U.S. Patent Application Publication No. 2005/0055250, Ohrt, U.S. Patent No. 7389246, Quido et al., U.S. Patent Application Publication No. 2003/0093302, Houle et al., U.S. Patent Application Publication No. 2003/0204421, Beery et al., U.S. Patent Application Publication No. 2001/0037223, Dhar et al., U.S. Patent Application Publication No. 2002/0040312, Eggebraaten et al., U.S. Patent Application Publication No. 2002/0120776 teach the environment of collaborating using web clients over the Internet.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Natalie A. Pass whose telephone number is (571) 272-6774. The examiner can normally be reached on Monday through Thursday from 9:00 AM to 6:30 PM. The examiner can also be reached on alternate Fridays.

12. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jerry O'Connor can be reached on (571) 272-6787. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

13. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or (571) 272-1000.

/N. A. P./  
Examiner, Art Unit 3686  
April 10, 2010

/Gerald J. O'Connor/  
Supervisory Patent Examiner  
Group Art Unit 3686